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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,430	03/29/2001	Mitchell M. Jackson	3085R	5042

7590 02/13/2004

THE LUBRIZOL CORPORATION  
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EXAMINER

TOOMER, CEPHIA D

ART UNIT PAPER NUMBER

1714

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/820,430

Applicant(s)

JACKSON ET AL.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15,18,19,31 and 33-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15,18,19,31,33-39 and 43-45 is/are rejected.
- 7) ☒ Claim(s) 40-42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 20, 2003 has been entered.
2. This Office action is response to the amendment filed November 20, 2003 in which claims 18, 19, 31, 33, 39 and 40 were amended; claim 32 was canceled and claims 43-45 were added.
3. Applicant's arguments, see page 6, last paragraph are persuasive regarding the hydrocarbyl substituent having a molecular weight of 700-3000. Therefore, the previous 103 rejections are withdrawn.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 15, 18, 31, 33-39 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly (US 6,224,642).

Daly teaches a fuel additive that is useful in improving fuel economy and reducing engine wear by enhancing the lubricity properties of fuels such as diesel, and gasoline. The additive may comprise a polyetheramine and a mixture of fatty acid esters and alkoxyated amines. The polyetheramine is prepared in substantially the same manner as the polyetheramine of the present invention (see abstract; col. 1, line 5-19; col. 2, lines 3-4). The alcohols useful in making the esters include polyhydric alcohols such as ethylene glycol, and glycerol (see col. 5, lines 48-51; col. 6, lines 4-10). The fatty acids used in preparing the esters contain from 8-22 carbon atoms (see col. 3, lines 31-33). The fatty acid ester is preferably a partial fatty acid ester of a polyhydric alcohol such as glycerol monooleate (see col. 6, lines 12-29).

The alkoxyated amines are of the formula set forth at col. 6, lines s30-35, wherein  $R^1$  is an alkyl or alkenyl group having about 14 to about 30 carbon atoms,  $R^2$  and  $R^3$  are vicinal alkylene groups and each x and y is an integer of at least 1, the total of x and y being about 6 or less (see col. 6, lines 38-43).

Daly teaches that conventional additives may be included in the fuel additive composition. The additive composition may be diluted with a normally liquid organic diluent such as benzene, toluene and xylene to form a concentrate. The concentrate contains from about 10-90% by weight of the additive (90-10% by weight solvent) and may contain one or more conventional additives (see col. 7, line 63 through col. 8, lines 1-3).

Daly differs from the claims in that he does not exemplify an additive composition wherein both the partial ester and alkoxyated amine are present. However, it would

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have been obvious to one of ordinary skill in the art to have combined these two components because Daly teaches that component (B) may be a mixture of two or more of the compounds that may be used as component (B).

Daly fails to teach that the concentrate composition is a liquid at a temperature from about 0 to minus 18 °C. However, since Daly has set forth that all of the recited components of his invention may be present in his fuel additive concentrate and he teaches all of the claimed components, it would be reasonable to expect that the additive concentrate of his invention would be a liquid at a temperature from 0 to minus 18 °C.

6. Claims 40-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach or suggest the addition of a pour point depressant.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schilowitz (US 5,720,782) teaches that pour point depressants are not normally added to gasoline.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in cursive script, reading "Cephia D. Toomer".

Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

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